

**REMARKS**

1        The Examiner rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by  
Bogert, et al. (5,810,785). Applicant respectfully disagrees with the Examiner's  
rejection. However, in an effort to expedite the prosecution of the present matter, claim  
5        1 has been amended to define a sealing face on said distal end of the sleeve that is  
generally transverse to a long axis of the sleeve. Furthermore, claim 1 has been  
amended to state that the gasket is positioned across a substantial portion of the  
sealing face on the distal end of the sleeve to permit selective sealing engagement with  
the coracoid process when the distal end of said tube is positioned in the glenoid vault.

10       Bogert, et al. fail to teach or otherwise suggest a devise with such a structural  
arrangement. It is this arrangement that permits a sealing engagement not only  
between the tube and the sleeve but also between the sleeve and the bone. The  
structural arrangement of the Bogert, et al. device is incapable of performing the  
15       procedure for which the present device was designed. Accordingly, claim 1 is believed  
to be allowable, since a claim is anticipated only if each and every element as set forth  
in the claim is found, either expressly or inherently described, in a single prior art  
reference. Verdegaal, Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2  
USPQ2d 1051, 1053 (Fed. Cir. 1987).

20       The Examiner is rejecting claim 8 under 35 U.S.C. § 102(b) as being anticipated  
by LaBash (5,499,989). Applicant respectfully disagrees with the Examiner's rejection.  
However, in an effort to expedite the prosecution of the present matter, claim 8 has  
been amended to include a suction mechanism coupled with the proximal end of the  
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1 tube. LaBash is a punch-style mechanism that is used to "core" a portion of tissue  
5 using a hollow punch. No suction mechanism is disclosed. Rather, the LaBash  
reference teaches away from common biopsy devices using an aspirating needle.  
Accordingly, LaBash not only fails to teach the structure as claimed but a person of  
ordinary skill in the art looking to create the applicant's device would not look, on any  
10 objective basis, to the LaBash reference. Accordingly, claim 8 is believed to be  
5 patentably distinct from the prior art.

15 The Examiner rejected claims 1-4 under 35 U.S.C. § 103(a) as being  
unpatentable over Morrey, et al. (5,704,909) in view of Bonutti (5,403,317). The  
10 Examiner states that Morrey, et al. disclose a tool having all of the structural limitations  
found within claims 1-4 except for a sleeve that is slidably coupled to the exterior of a  
suction tube. The Examiner states, however, that Bonutti teaches such a structural  
arrangement. The Examiner argues that it would have been obvious to one of ordinary  
15 skill in the art at the time the invention was made to combine the Morrey, et al. and  
Bonutti references in order to derive the surgical tool as claimed. The applicant  
respectfully disagrees.

20 In determining the difference between the prior art and the claims, the question  
under 35 U.S.C. § 103 is not whether the differences themselves would have been  
obvious, but whether the claimed invention as a whole would have been obvious.  
25 Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). A  
prior art reference and the claimed invention must be considered in their entireties.  
Distilling an invention down the "jist" or "thrust" of an invention disregards the

requirement of analyzing the subject matter "as a whole." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *Cert. denied*, 469 U.S. 851 (1984).

Claim 1 has been amended to define a sealing face on said distal end of the sleeve that is generally transverse to a long axis of the sleeve. Claim 1 has also been amended to state that the gasket is positioned across a substantial portion of the sealing face on the distal end of the sleeve to permit selective sealing engagement with the coracoid process when the distal end of said tube is positioned in the glenoid vault. Neither Morrey, et al. nor Bonnutti teach these structural arrangements. Bonnutti fails to discuss the use of a face portion on the distal end of its sleeve. Moreover, Bionutti doesn't teach a sealing engagement between its sleeve and tube. Rather Bonutti teaches the flow of fluids between the two structures. Accordingly, giving full benefit to the teachings of both references, the prior art fails to provide the teachings, suggestions or motivations necessary to support a rejection of claims 1-4 under 35 U.S.C. § 103.

The mere fact that the references can be modified does not render the resulting modified structure obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). "A statement that modifications of the prior art meet the claimed invention and would have been 'well within the ordinary skill in the art at the time the claimed invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art' is not sufficient to establish a *prima facie* case of

obviousness without some objective reason to combine the teachings of the  
1 references." Ex parte Leavengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Just because a structural detail is simple and known for other purposes, does not render it "obvious". In re Kotzab, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000), the Federal Circuit Court of Appeals decided that the control of multiple valves by a single  
5 sensor rather than by multiple sensors was a technologically simple concept. However, the Federal Circuit held that there was no finding as to the specific understanding or principal within the knowledge of the skilled artesian that would have provided the motivation to use a single sensor as the system to control more than one valve. The  
10 claimed structural design of applicant's device is an example of such a patentable structure born from a technologically simple concept. More importantly, there is no teaching or suggestion that would render the claimed combination of elements "obvious". Ex parte Leavengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). Accordingly, the combinations of claimed elements within claims 1-4 are believed to be  
15 patentable and the Examiner is respectfully requested to reconsider the aforementioned rejections and to allow claims 1-4.

Finally, the Examiner has rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Morrey, et al. and Bonutti in further view of Lee et al. (5,693,030).  
20 Specifically, the Examiner states that the previously discussed combination of Morrey, et al. Bonutti teach all of the limitations found within claim 5, but for the obturator that may be extended in the tube for cleaning debris, which is argued by the Examiner to be taught by U.S. Patent No. 5,693,030 to Lee. The Examiner states that it would have  
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1       been obvious to a person of ordinary skill in the art at the time the invention was made  
1       to combine these references in order to derive the invention as claimed. Applicant  
respectfully disagrees. Claim 5 depends from claim 1 is believed to be allowable for at  
least the reasons set forth hereinabove with respect to claim 1.

5       New claims 9-12 have been added and each ultimately depend from claim 1.  
5       Accordingly, claims 9-12 are believed to be allowable for at least the reasons set forth  
herein above with respect to claim 1. Claim 9 further adds a suction mechanism,  
capable of generating a suction force, operatively coupled with the proximal end portion  
of the tube. This structural arrangement, dictated by the limitations within claim1, is not  
10      taught or otherwise suggested within the prior art. Claim 10 further includes the  
limitation that the proximal end of said tube is shaped and sized to have a diameter  
greater than an intermediate portion of said tube; said bend, adjacent the distal end of  
said tube, and the proximal end of said tube being shaped and sized relative to said  
15      tube to substantially prevent unintended removal of said sleeve from said tube. No  
such structural arrangement is found in the relevant prior art. Claims 9-12 are believed  
to be patentably distinct from the prior art and their consideration and allowance is  
respectfully requested.

20      New claims 13-16 have been added and each ultimately depend from claim 8.  
20      Accordingly, claims 13-16 are believed to be allowable for at least the reasons set forth  
herein above with respect to claim 8. Moreover, the structural arrangements and  
combinations specifically found within these claims are not taught or otherwise  
suggested within the prior art. Accordingly, claims 13-16 are believed to be patentably  
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1 distinct from the prior art and their consideration and allowance is respectfully  
requested.

5 In light of the above amendments and remarks, applicant asserts that the claims  
are in condition for allowance. Applicant respectfully requests reconsideration and  
allowance of the same.

10 No fees or extensions of time are believed to be due in connection with this  
amendment; however, please consider this a request for any extension inadvertently  
omitted, and charge any additional fees to Deposit Account No. 502093.

15 Respectfully submitted,



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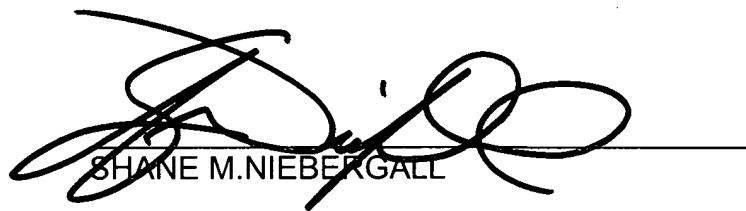


**CERTIFICATE OF MAILING**

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I hereby certify that the original of this AMENDMENT for R. MICHAEL GROSS, Serial No. 10/046,592, was mailed by first class mail, postage prepaid, to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 14th day of December, 2005.

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